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EXAMINER	
GRUMBLING, M	
ART UNIT	**PAPER NUMBER**
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DATE MAILED: 04/02/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☑ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), ____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☑ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☑ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☑ Claims 1-40 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☑ Claims 1-9, 11-19, 21, 22, 26, 30-40 are rejected.

5. ☑ Claims 10, 20, 23-25, 27-29 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Claims 1-40 are generic to a plurality of disclosed patentably distinct species comprising compounds, compositions and methods of use in which A is (i)-(vii) or one of the other sub-formulae of which A consists. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

The references cited but not provided by applicants have not been considered because they are not readily available to the examiner. Applicants are requested to furnish those references cited but not provided in order to complete the record.

Claims 2-9, 11-14, 16, 17, 19 and 21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 21, page 99, about line 20, there is a mismatch of open and close parentheses and brackets. It is therefore unclear what species is being claimed here.

4) Claims depend from claim 1 and recite "claim 1" twice. While this is not per se indefinite, it is prolix since it is understood that all variables not defined in the dependent claim

are defined in the claim from which it depends. It is requested that the claims be amended to delete the extra recitation of "claim 1".

5) The claims not specifically mentioned above depend from the claims specifically mentioned and do not overcome the rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 12-16, 18, 22, 26 and 30-40 are rejected under 35 U.S.C. § 102(b) as being anticipated by Omar et al. The claims read on for example compound 12, recited on page 78 of the reference.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same

person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1-3, 12-16, 18, 22, 26 and 30-40 are rejected under 35 U.S.C. § 103 as being unpatentable over Omar et al. The claims read on, for example compound 12, recited on page 78 of the reference. The claims differ from the reference in that they recite different scope and different species than are taught by the reference. However, one of ordinary skill in the art would have been motivated to prepare compounds related to the instant compounds as analogs, homologs and ring position isomers, including those of the instant claims, because they are so structurally similar to those specifically taught by the reference that they would be expected by one of ordinary skill in the art to possess similar properties.

Claims 10, 20, 23-25 and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of

record neither teaches nor suggests the compounds of the instant claims.

Applicants are requested to furnish any references cited in the specification but not previously provided in order to complete the record and because they are not readily available to the examiner. The references cited and considered in the parent case, 08/364,624 have been considered. Those not considered in the parent case because they were not provided to the Office have not been considered for reasons set forth therein.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The title is objected to as being prolix for containing the word "Novel" which is not permitted in the title of US patents. Amendment to strike "Novel" is requested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew V. Grumbling whose telephone number is (703) 308-4713. The examiner can usually be reached on Monday through Friday from 9:30 a.m until 6:00 p.m.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine are (703) 308-4556 or 305-3592.

Since the facsimile machines possess limited capacity it is requested that information disclosures, appeal briefs and other communications greater than 15 pages in length be mailed rather than submitted by facsimile. Also it is requested that communication not intended to be entered in the case (such as courtesy copies) be conspicuously marked "DRAFT" on the cover sheet of the facsimile transmission.

Matthew V. Grumbling
Patent Examiner
GAU 1202
April 1, 1996